

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C. 20436

In the Matter of)	
)	
)	
CERTAIN BEARINGS AND)	Inv. No. 337-TA-469
PACKAGING THEREOF)	
)	

**NOTICE OF COMMISSION DETERMINATION TO REVIEW-IN-PART A
FINAL INITIAL DETERMINATION FINDING A VIOLATION OF
SECTION 337; SCHEDULE FOR FILING WRITTEN SUBMISSIONS ON
THE ISSUES UNDER REVIEW AND ON REMEDY, THE
PUBLIC INTEREST, AND BONDING**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined to review-in-part the final initial determination (ID) issued by the presiding administrative law judge (ALJ) on April 10, 2003, finding a violation of section 337 of the Tariff Act of 1930, 19 U.S.C. § 1337, in the above-captioned investigation. Specifically, the Commission has determined to review the issues of registered and common law trademark infringement, false representation as to source, and laches. The Commission has also determined to affirm ALJ Order No. 95, which disqualified complainant's expert witness on the issue of quality control.

FOR FURTHER INFORMATION CONTACT: Jean Jackson, Esq., Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 205-3104. Copies of the ALJ's IDs and all other nonconfidential documents filed in connection with this investigation are or will be available for inspection during official business hours (8:45 a.m. to 5:15 p.m.) in the Office of the Secretary, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone 202-205-2000. General information concerning the Commission may also be obtained by accessing its Internet server (<http://www.usitc.gov>). The public record for this investigation may be viewed on the Commission's electronic docket (EDIS-ON-LINE) at <http://edis.usitc.gov>. Hearing-impaired persons are advised that information on this matter can be obtained by contacting the Commission's TDD terminal on 202-205-1810.

SUPPLEMENTARY INFORMATION: The Commission instituted this investigation on April 16, 2002, based on a complaint filed by SKF USA, Inc. (SKF) of Norristown, PA against fourteen respondents. 67 *Fed. Reg.* 18632 (2002). Four respondents remain in the investigation, ten respondents have either settled with complainant or have been found in default. The complaint, as supplemented, alleged violations of section 337 of the Tariff Act of 1930 in the importation into the United States, sale for importation, and sale within the United States after importation of certain bearings by reason of infringement of registered and common law trademarks, dilution of trademarks, various acts in violation of the Lanham Act, and passing off. A count concerning "unfair pecuniary benefits" was dismissed by

the Commission on September 23, 2002.

On April 10, 2003, the ALJ issued his final ID on violation and his recommended determination (RD) on remedy. The ALJ found a violation of section 337 by reason of infringement of SKF's registered and common law trademarks by each of the four remaining respondents, *viz.*, Bearings Limited, Bohls Bearing and Transmission Service, CST Bearing Company, and McGuire Bearings Company, and recommended the issuance of a general exclusion order and cease and desist orders to the respondents found in violation. All parties remaining in the investigation, including the Commission investigative attorney, filed petitions for review on April 21, 2003, and replies to the petitions on April 28, 2003.

Having examined the record in this investigation, including the ALJ's final ID, the petitions for review, and the responses thereto, the Commission has determined to review the issues of registered and common law trademark infringement, false representation as to source, and laches. On review, the Commission requests briefing based on the evidentiary record on the issues under review and is particularly interested in receiving answers to the following questions:

1. In view of the fact that the parties have cited only one district court case finding gray market trademark infringement based solely on non-physical material differences,¹ please discuss any legal and policy bases for finding gray market trademark infringement and false representation of source where no physical differences exist between the authorized and unauthorized products. In addition, as part of the submission on remedy, please discuss any issues that would likely arise in the enforcement of a general exclusion order based solely on non-physical differences between the authorized and gray market bearings.
2. What types of warranty, product recall procedures, and post-sale services accompany sales of authorized SKF USA bearings in the following categories: (a) sales of SKF USA bearings by Chicago Rawhide; (b) sales of SKF USA bearings under the Roller Bearing Company/Tyson Bearing Company License Agreement; (c) downstream sales of SKF USA bearings by unauthorized distributors, *e.g.*, the three entities discussed on pp. 32-34 of Respondents' Confidential Joint Petition for Review, dated April 21, 2003; (d) sales of SKF USA bearings downstream from authorized SKF USA distributors; (e) sales of SKF USA bearings on the surplus market, (f) sales of SKF USA bearings by formerly authorized distributors, *e.g.*, by Bohls Bearings and Power Transmission Service; (g) sales of SKF USA bearings by respondents who have entered into settlement agreements with complainant in this investigation; (h) downstream sales of SKF USA bearings by original equipment manufacturers that have purchased bearings from SKF USA or its authorized distributors? Based on the evidence of record, please quantify the size of these types of sales to the extent possible. Please compare and contrast the warranties, product recall procedures, and post-sale services that accompany these categories of sales with the warranties, product recall procedures, and post-sale

¹ *Osawa & Co. v. B & H Photo*, 589 F. Supp. 1163, 1167-68 (S.D.N.Y. 1984). The parties also cited *Philip Morris, Inc. v. Allen Distribs., Inc.*, 48 F. Supp.2d 844, 853 (S.D. Ind. 1999). That case, however, found a physical material difference in that packages of authorized cigarettes had a particular Universal Product Code (UPC) on their side panel which consumers accumulated and redeemed for merchandise, while the gray market cigarette packages lacked this UPC label. *Philip Morris*, 48 F. Supp.2d at 848.

services that accompany the sales of gray market bearings by respondents.

3. In determining what comprises the bundle of services that are integral to the authorized bearings originally put into commerce in the United States by complainant SKF USA, what basis, if any, exists for excluding the categories of bearings listed above in Question 2? In order to find trademark infringement and false designation of source, is it necessary for the Commission to find that SKF USA's bundle of services accompanies sales of *substantially all* its authorized bearings and differs materially from the bundle of services that accompany the gray market bearings sold by respondents?
4. Please discuss the evidence of record that relates to actual consumer confusion based on warranties, product recall procedures, and post-sale services offered in respect to the authorized and gray market bearings.
5. How does the element of likelihood of consumer confusion factor into the legal standard for finding gray market trademark infringement based solely on non-physical material differences?
6. With respect to non-physical material differences based on SKF USA's post-sale technical and engineering support services, of what relevance is the fact that SKF USA will provide post-sale customer support to consumers who buy SKF bearings from SKF USA authorized distributors even if the authorized distributors have obtained the bearings from the gray market?
7. Please discuss the material differences, if any, between warranties provided by SKF USA and warranties that are express or implied under the UCC, as adopted by the relevant states.

In connection with the final disposition of this investigation, the Commission may (1) issue an order that could result in the exclusion of the subject articles from entry into the United States, and/or (2) issue one or more cease and desist orders that could result in respondents being required to cease and desist from engaging in unfair action in the importation and sale of such articles. Accordingly, the Commission is interested in receiving written submissions that address the form of remedy, if any, that should be ordered. If a party seeks exclusion of an article from entry into the United States for purposes other than entry for consumption, the party should so indicate and provide information establishing that activities involving other types of entry that either are adversely affecting it or likely to do so. For background, see *In the Matter of Certain Devices for Connecting Computers via Telephone Lines*, Inv. No. 337-TA-360, USITC Pub. No. 2843 (December 1994) (Commission Opinion).

If the Commission contemplates some form of remedy, it must consider the effects of that remedy upon the public interest. The factors the Commission will consider include the effect that an exclusion order and/or cease and desist orders would have on (1) the public health and welfare, (2) competitive conditions in the U.S. economy, (3) U.S. production of articles that are like or directly competitive with those that are subject to investigation, and (4) U.S. consumers. The Commission is therefore interested in receiving written submissions that address the aforementioned public interest factors in the context of this investigation.

If the Commission orders some form of remedy, the President has 60 days to approve or disapprove the Commission's action. During this period, the subject articles would be entitled to enter the United States under a bond, in an amount determined by the Commission and prescribed by the Secretary of the Treasury. The Commission is therefore interested in receiving submissions concerning the amount of the bond that should be imposed.

WRITTEN SUBMISSIONS: The parties to the investigation are requested to file written submissions on the issues under review. The submission should be concise and thoroughly referenced to the record in this investigation. Parties to the investigation, interested government agencies, and any other interested parties are encouraged to file written submissions on the issues of remedy, the public interest, and bonding. Such submissions should address the April 10, 2003, recommended determination by the ALJ on remedy and bonding. Complainant and the Commission investigative attorney are also requested to submit proposed remedial orders for the Commission's consideration. The written submissions and proposed remedial orders must be filed no later than close of business on June 6, 2003. Reply submissions must be filed no later than the close of business on June 13, 2003. No further submissions on these issues will be permitted unless otherwise ordered by the Commission.

Persons filing written submissions must file the original document and 14 true copies thereof on or before the deadlines stated above with the Office of the Secretary. Any person desiring to submit a document (or portion thereof) to the Commission in confidence must request confidential treatment unless the information has already been granted such treatment during the proceedings. All such requests should be directed to the Secretary of the Commission and must include a full statement of the reasons why the Commission should grant such treatment. *See* section 201.6 of the Commission's Rules of Practice and Procedure, 19 C.F.R. § 201.6. Documents for which confidential treatment by the Commission is sought will be treated accordingly. All nonconfidential written submissions will be available for public inspection at the Office of the Secretary.

The authority for the Commission's determination is contained in section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337), and in section 210.43 of the Commission's Rules of Practice and Procedure (19 C.F.R. § 210.43).

By order of the Commission.

Marilyn R. Abbott
Secretary to the Commission

Issued: May 28, 2003